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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,090	07/09/1999	STEFAN LANGE	REF/970230/L	9256

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/297,090	GORANSSON ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26,33,34 and 41-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26,33,34,41-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted December 2, 2003 is acknowledged.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 26, 42, 43, 45, 46, 49, 50, 52, 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnston (U.S. Patent 5,565,225), in view of the fact about malted cereal disclosed in Witt et al. (US 4,241,183, of record) for reasons set forth in the prior office action. With respect to the newly added limitation, "to induce in the animal at least 0.5 units of antisecretory protein per ml of blood." Note the instant claims are directed to effecting a biochemical pathway with an old and well known food products. The argument that such claims are not directed to the old and well known ultimate utility are not probative. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various

biochemical function. The Ultimately utility of malted cereal as food products is well known. Consumption of the malted food product would have anticipated the instant claims.

Claim Rejections 35 U.S.C. – 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 26, 33, 34, 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (US 5,565,225) in view of Lange et al. (U.S. 5,296,243), and in further view of Robbins et al. (CAPlus abstract, AN 1972:111657), Aspinal et al. (Caplus abstract, AN 1956:30292), and Witt et al. (US 4,241,183, of record). With respect to the newly added limitation, "to induce in the animal at least 0.5 units of antisecretory protein per ml of blood." Note the instant claims are directed to effecting a biochemical pathway with an old and well known food products. The argument that such claims are not directed to the old and well known ultimate utility are not probative. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical function. The ultimate utility for the

claimed food product is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103. With respect to newly added claims 56-58, which recite particular food form, note it is within the skilled artisan to use cereal product containing malted cereal to make various food, therefore, claims 56-58 are obvious over the cited prior art.

2. Claims 26, 33, 34, 41-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolles et al. (US 4,834,989) and Camburn (US 5,552,175) in view of Witt et al. (US 4,241,183) for reasons set forth in the prior office action. With respect to the newly added limitation, "to induce in the animal at least 0.5 units of antisecretory protein per ml of blood." Note the instant claims are directed to effecting a biochemical pathway with an old and well known food products. The argument that such claims are not directed to the old and well known ultimate utility are not probative. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical function. The ultimate utility for the claimed food product is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103. With respect to newly added claims 56-58, which recite particular

food form, note it is within the skilled artisan to use cereal product containing malted cereal to make various food, therefore, claims 56-58 are obvious over the cited prior art.

Response to the Arguemnts

Applicants' amendments and remarks submitted December 2, 2003 have been fully considered, but are not persuasive for reasons discussed above.

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4. Applicants contend that it is a surprising discovery that "malted cereal can be utilized without prior cooking to form at a sufficient rate, such amount of sugars and amino acids." The examiner was not convinced. Note a malting process is a process of degradation of protein and polysaccharide to small molecules such as sugar and amino acid.

5. As to the remarks about diarrhea, note the instant claims are direct to *regulating* flux of fluid. Any of those malted cereal product would have been expected to be useful in regulating flux of fluid in view of the cited references.

6. With respect to the rejections under 35 U.S.C. 102, as discussed, whether Johnston expressly teaches the functions herein is not relevant. The issue is would the practice of Johnston's method read on the instant claims. The examiner was convinced that practice of Johnston's method, which comprising administering malted cereal to animal, read on the instant claims.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Note Robins et al. and Aspinal et al. were cited to show that malted cereals contain amino acid and sugar. Long et al. teaches that amino acid and sugar are beneficial for regulating the flux of fluid. Therefore, one of ordinary skill in the art would have reasonably expected that the malted cereals as disclosed by Johnston are useful in regulating the flux of fluid.

8. With respect to the rejections under 35 U.S.C. 103 over Bolles et al., Camburm and Witt et al. Applicants traverse the rejection on the ground that the cited references do not teaches the functions herein, i.e., induction of antisecretory proteins and regulating the flux of fluid. As discussed in the prior office action and above, the functional limitation carries no patentable weight insofar as the claimed method is obvious. The claimed method is directed to administering malted food product to animal, particularly human. The cited reference teaches such malted food product. The consumption of such food product by human is obvious, and such consumption would effectively practice the claimed invention. Note, one of ordinary skill in the art would have understood that liquefaction of starch means degradation of macromolecules into small molecules, i.e., sugars, amino acids.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang

March 30, 2004